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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/632,375	08/01/2003	Mikio Uchida	AA540C	4170

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THE PROCTER & GAMBLE COMPANY
INTELLECTUAL PROPERTY DIVISION
WINTON HILL TECHNICAL CENTER - BOX 161
6110 CENTER HILL AVENUE
CINCINNATI, OH 45224

EXAMINER	
CHANNAVAJJALA, LAKSHMI SARADA	

ART UNIT	PAPER NUMBER
1615	

DATE MAILED: 04/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/632,375	UCHIDA ET AL.	
	Examiner	Art Unit	
	Lakshmi S Channavajjala	1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *9-22-03*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Receipt of IDS dated 9-22-03 is acknowledged.

Claims 1-20 are pending.

Instant claims are directed to an anhydrous cosmetic composition comprising an inorganic heat generating agent that generates heat by mixing with water, a phase changing agent such as a fatty alcohol, and an inert carrier, wherein the phase changing agent has a melting point of from about 30 degrees C to about 70 degrees C and are dispersed in the inert carrier. The composition further comprises a polyoxyalkylene derivative, a cellulose derivative, amidoamines together with an acid. The composition is used for hair care.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 1-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 and 18 of copending Application No. 10/273,816. Although the conflicting claims are not identical, they are not

patentably distinct from each other. The copending claims directed to an anhydrous cosmetic composition recite hydrophilic and hydrophobic polyols such as polyethylene glycol and polypropylene glycol, which read on the claimed inert carrier. The copending claims recite the same inorganic heat generating elements of the same particle size, polyoxyalkylene derivatives, and oily conditioning compounds that are also claimed in the instant claims. The copending composition has the same melting point as that of instant claim 13. The claims of the copending application recite fatty alcohols and esters that read on the instant fatty compounds. Further, the copending composition is used for the same purposes as that of the instant claims. Therefore, the claims of the co-pending claims anticipate the instant claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

2. Claims 1-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23 of copending Application No. 10/632,279. Although the conflicting claims are not identical, they are not patentably distinct from each other because the anhydrous composition of the copending claims also comprises the same components i.e., a heat generating agent, an inert carrier and a phase changing agent. The exact specific compounds that are encompassed by the heat generating agent, inert carrier and a phase changing agent of the instant depending claims are also claimed by copending claims. Instant dependent claims recite polyoxyalkylene derivative, amidoamines composition, and fatty alcohols, all of which are also claimed by the copending claims. Accordingly, instant claims are anticipated by the claims of copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 4, 6-7 and 12-14 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 897719 (EP 719).

EP 719 discloses topical cleansing composition comprising a solid heat generating material that generates heat upon mixing with water, an anionic surfactant and an anhydrous carrier or diluent. The heat generating material of EP 917 is aluminum silicate (Zeolite), which is anhydrous (page 2, lines 34-35 and 45) and the surfactant is polyoxyethylene ether or polyoxyethylene sorbitol (page 4, lines 18-21). Besides Zeolite, polyoxyethylene sorbitol, Table 1 on page 4 of EP 917 discloses PEG 400 almond oil, which read on the instant claimed inert carrier (of instant claims 1, 4 and 6-7) and recites sodium carboxymethyl cellulose that read on claimed cellulose derivatives (claim 12). Further, the polyoxyethylene sorbitol of EP 917 (table 1) meets the limitation of claim 4. EP 917 discloses the components of instant claim 1 and hence the property of warming to a temperature of between 30 and 80 degrees C is inherent to the composition. The cleansing composition of EP 917 reads on shampoo of claim 14. Thus, EP 917 anticipates instant claims.

4. Claims 1-4, 6, 7, 9 and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by US 2002/0051798 to Koike et al ('798).

Koike discloses a gommage composition that generates heat upon contact with water and gives the user an excellent feeling to the user, comprising a component that generates heat upon contact with water such as magnesium chloride, calcium chloride, magnesium sulfate etc (0020); a substance that is liquid at 25 degrees C (other then water) (0017) comprising polyethylene glycol, lower alcohols, glycerol or oils; non-aqueous solvents (0018); and other surfactants. The composition of '798 is free of water (oo19) and thus reads on the instant "anhydrous" composition. Table 4 of '798 disclose in addition to the above components, behenyl alcohol, cellulose and polyoxyethylene castor oil, which read on the instant claimed, fatty alcohols, cellulose derivatives and polyoxyalkylene derivatives respectively. Accordingly, '798 anticipate instant claims.

5. Claims 1-20 are rejected under 35 U.S.C. 102(e) as being anticipated by US application 10/273,816 (PGPUB No. 2003/0108502).

The applied reference has common inventors with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

10/273,816 discloses anhydrous cosmetic compositions for hair care and conditioning, comprising the instant inorganic heat-generating agent, polyoxyalkylene derivatives, reaction control agents, phase changing materials such as fatty acids, fatty alcohols etc, amido amines, acids and viscosity modifying agents, including the claimed percentages (see entire disclosure). Thus, 10/273,816 anticipates instant claims.

Claims 1-20 are directed to the same invention as that of claims 1-18 of commonly assigned 10/273,816. The issue of priority under 35 U.S.C. 102(g) and possibly 35 U.S.C. 102(f) of this single invention must be resolved.

Since the U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302), the assignee is required to state which entity is the prior inventor of the conflicting subject matter. A terminal disclaimer has no effect in this situation since the basis for refusing more than one patent is priority of invention under 35 U.S.C. 102(f) or (g) and not an extension of monopoly.

Failure to comply with this requirement will result in a holding of abandonment of this application.

6. Claims 1-20 are directed to the same invention as that of claims 1-23 of commonly assigned 10/632,279 (PGPUB No. 2004/0022823). The issue of priority under 35 U.S.C. 102(g) and possibly 35 U.S.C. 102(f) of this single invention must be resolved.

Since the U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302), the assignee is required to state which entity is the prior inventor of the conflicting subject matter. A terminal disclaimer has no effect in this situation since the basis for refusing more than one patent is priority of invention under 35 U.S.C. 102(f) or (g) and not an extension of monopoly.

Failure to comply with this requirement will result in a holding of abandonment of this application.

7. The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302). Commonly assigned 10/273,816 and 10/632,279, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee is required under 35 U.S.C. 103(c) and 37 CFR 1.78(c) to either show that the conflicting inventions were commonly owned at the time the invention in this application was made or to name the prior inventor of the conflicting subject matter. Failure to comply with this requirement will result in a holding of abandonment of the application.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly

assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications filed on or after November 29, 1999.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 5 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over US2002/0051798 to Koike et al ('798).

'798 discussed above, fails to teach the specific alcohols and the combination of specific alcohols with polyethylene glycol as an inert carrier. However, '798 teach a combination of behenyl alcohol and polyethylene glycol (tables 3 and 4). '798 teaches the composition for the

same purposes as that of the instant invention i.e., generating heat upon contact with water comprising the ingredients such as the inorganic heat generating agents, polyethylene glycol, etc., which primarily to the heat generating effect. Further, the examples include fatty alcohols in the composition. Accordingly, in the absence of any criticality showing unexpected advantage with cetyl or stearyl alcohols, it would have been obvious for one of an ordinary skill in the art at the time of the instant invention to use a suitable fatty alcohol such as a behenyl alcohol or stearyl or cetyl alcohol such that the heat generating and cleansing effect of the composition is not compromised.

9. Claims 15-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over US2002/0051798 to Koike et al ('798) in view of US 6,540,989 to Janchitraponvej ('989).

'798 also fail to teach the composition for hair conditioning and lacks amidoamines of instant claims.

'989 teach a self-warming hair care composition comprising a glycol, a quaternary ammonium compound, an amidoamines and a silicone. The composition of '989 is anhydrous and upon contact with water generates heat giving the user a pleasant feeling and also the conditioning ability (col. 1). '989 teach amidoamines (col. 3, lines 41-55; col. 5) and fatty alcohols (col. 4, lines 26-30; col. 5) that are also described in the instant specification. '989 also teach polyoxyalkylene derivatives. Therefore, it would have been obvious for one of an ordinary skill in the art at the time of the instant invention to add amido amine of '989 to the composition of '798 and use the composition for hair care such as hair conditioning because '989 teaches that

a heat generating composition that is self-warming gives a warm feeling to use and also provides good conditioning because of the presence of amido amine that acts as a deposition aid and a conditioner. Accordingly, the expected result would be to effectively condition hair as well as provide a warmth sensation to use indicating that the composition is working effectively. Further, with respect to the ratio of amidoamines and acid claimed, '989 teach that a clear conditioning composition is obtained with amino acid neutralized with acid. Accordingly, optimizing the ratio of amido amine and acid so as to obtain an effective conditioning effect.

10. Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over US2002/0051798 to Koike et al ('798) by itself or '798 in view of EP 027 730 (EP 730).

Claim 9-11 recite polyoxyalkylene derivatives, in particular claim 8 recites polyoxyethylene/polyoxypropylene block copolymer. '798 fail to specifically teach the claimed polyoxyalkylene derivatives of the instant claims.

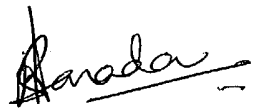
EP '730 teaches cosmetic compositions for hair or skin treatment, comprising heat generating compounds when brought into contact with water (page 3). Among the heat generating compounds EP 730 teaches fatty alcohols, alkylene glycols and polyoxyalkylene derivatives (page 5, in particular lines 8-19 and page 6, lines 8 to page 7, lines 13). More specifically EP 730 teaches the claimed polyoxyethylene and polyoxypropylene copolymer (example 4 on page 12). Therefore, it would have been obvious for one of an ordinary skill in the art at the time of the instant invention to use the pluronic or any other suitable polyoxyalkylene derivatives as heat generating agents in the composition of '798 because EP 730 teaches that the above polyoxyalkylene derivatives are preferable as heat generating compounds (page 8) and

suggests that the heat generating compounds give an excellent finishing and cleansing effect to the consumer upon application, which results in a comfortable hot feeling.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lakshmi S Channavajjala whose telephone number is 571-272-0591. The examiner can normally be reached on 7.30 AM -4.00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K Page can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Lakshmi S Channavajjala
Examiner
Art Unit 1615

April 15, 2004